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March 14, 2008

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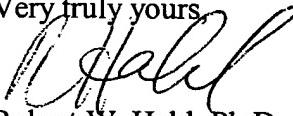
Re: Notice of Appeal to the CAFC in U.S. Pat. Appl.
Ser. No. 10/733,292, filed December 12, 2003
Neifeld Docket No. EDWA0018U-US

Dear Sir or Madam,

Enclosed please find the original Notice of Appeal (NOA) of the Decision on Rehearing, Appeal No. 2007-0850, of the USPTO Board of Patent Appeals and Interferences, decided January 23, 2008, by the USPTO Board of Patent Appeals and Interferences in U.S. Patent Application Serial No. 10/733,292, filed December 12, 2003. The Decision on Appeal dated May 18, 2007, and a Petition to the Director under 37 C.F.R. §1.181, to correct an erroneously issued Notice of Abandonment are also enclosed.

Three sets of copies of the present Notice of Appeal, the Decision on Rehearing decided January 23 2008, the Decision on Appeal dated May 18, 2007, and a Petition to the Director under 37 C.F.R. §1.181, to correct an erroneously issued Notice of Abandonment, are being served on the Clerk's Office, United States Court of Appeals for the Federal Circuit, via U.S. Postal Service Express Mail, with a check for the required fee of \$450.00.

Very truly yours,


Robert W. Hahl, Ph.D.
Patent Attorney
Neifeld IP Law, PC

United States Court of Appeals for the Federal Circuit

Geoffrey H. White and Weiyun Yu, Appellant,

v.

NOTICE OF APPEAL

Director, United States Patent and Trademark Office

Geoffrey H. White and Weiyun Yu hereby appeal the court for review of the Decision on Rehearing, Appeal No. 2007-0850, of the USPTO Board of Patent Appeals and Interferences, decided January 23, 2008; notification date January 25, 2008.

Appellant filed a Request for Rehearing on July 3, 2007, which was timely since that date is within two months of the Decision on Appeal decided May 18, 2007 (37 C.F.R. §41.52(a)). The Request for Rehearing was denied, in a Decision on Rehearing decided January 23, 2008. This Notice of Appeal is timely since it is being filed within two months of January 23, 2008 (37 C.F.R. §1.304).

However, a Notice of Abandonment was erroneously issued on March 7, 2008, in U.S. Application Serial No. 10/733,292, by the United States Patent and Trademark Office. It appears that the examiner did not realize that a Request for Rehearing had been filed on July 3, 2007, or that the time for filing a Notice of Appeal in this situation is governed by 37 C.F.R. §1.304. A Petition to the Director under 37 C.F.R. §1.181 was filed on March 14, 2008 to correct the error.

Respectfully submitted,

R. Hahl
3.14.08

Date

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RAN: Attorney Review & Act on Decision: 2/24/08
BTM: Call BPAI clerk and ask for a verbal status; email report to RAN CLEARED
BTM: Escalate status check of request for rehearing CLEARED

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte GEOFFREY H. WHITE and WEIYUN YU

Appeal 2007-0850
Application 10/733,292
Technology Center 3700

Decided: January 23, 2008

Before DEMETRA J. MILLS, ERIC GRIMES, and LORA M. GREEN,
Administrative Patent Judges.

GRIMES, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

Appellants have requested rehearing of the decision entered May 18, 2007 (hereafter “Decision”). The Decision entered new grounds of rejection of claims 12-36 under 35 U.S.C. §§ 102(e) and 103. We decline to withdraw the new grounds of rejection. The request for rehearing is denied.

DISCUSSION

Appellants address their arguments on rehearing to claim 12 (Req. Reh'g 4). Therefore, claims 13-36 stand or fall on rehearing with claim 12. 37 C.F.R. § 41.37(c)(1)(vii).

Appellants argue that Piplani's statement that the apices in its device extend "a substantial distance beyond the open end" of the device is an inadequate basis on which to conclude that the apices extend far enough to extend across a lumen of a second vessel, as required by claim 12 (Req. Reh'g 6). Appellants argue that "'substantial' is a relative term. Piplani provides no metric to specify what 'substantial' means." (*Id.*) "[A]ll 'substantial' means is not insubstantial. It does not for example mean at least 1, 3, 5, or 15 millimeters." (*Id.* at 7.)

This argument is not persuasive. Appellants provide no evidentiary basis for their assertion that those skilled in the art would not have understood Piplani's "substantial distance" to mean at least 1, 3, 5, or 15 millimeters, distances which in any case are not recited in claim 12. Nor have Appellants provided any evidence to rebut our reasoning that "[i]n view of the drawings, the explicitly stated dimensions, and the disclosure that one set of wire apices extends 'a substantial distance' from the body of the graft, it is reasonable to conclude that the wire apices of Piplani's device would extend a sufficient distance from the body of the graft such that the apices would be capable of extending across the lumen of an intersecting vessel" (Decision 10-11).

Appellants argue that our reliance on *In re Best*, 562 F.2d 1252, 1254-55 (CCPA 1977), is improper because "Best relates to products formed by a

process wherein the novel property ascribed to the claimed product results from alleged differences in the process of its manufacture,” while “[n]o allegedly novel feature of a composition of matter based upon a process of making a composition is involved in this case” (Req. Reh’g 6). Appellants also argue that they made the showing required by *Best* “in their appeal brief, pointing out that Piplani did not expressly or inherently disclose” (*id.*).

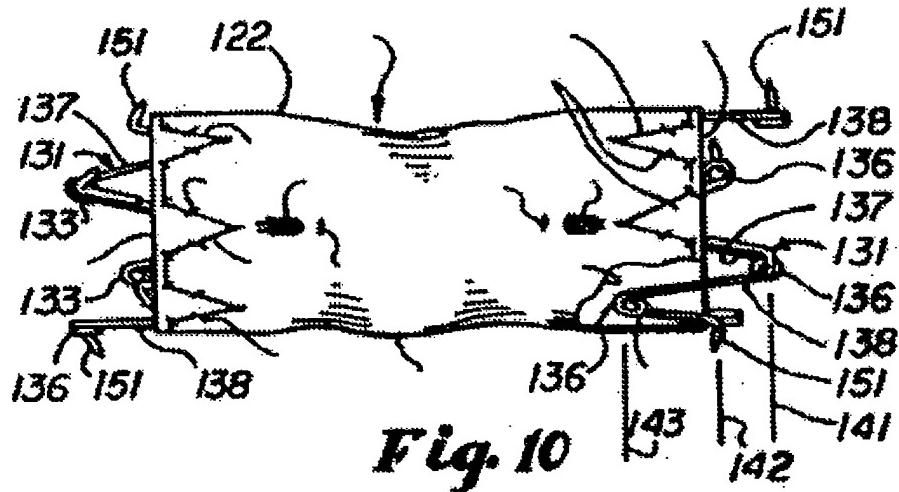
We disagree with Appellants’ interpretation of the case law. The shifting of evidentiary burdens described in *Best* applies in contexts other than that of comparing chemical compositions. *See, e.g., In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990) (“[W]hen the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.”). The rebuttal is not limited to comparative testing of claimed and prior art products, but can take a variety of forms. *See id.* (“In response to the PTO’s asserted *prima facie* case the applicant may argue that the inference of lack of novelty was not properly drawn, for example if the PTO did not correctly apply or understand the subject matter of the reference, or if the PTO drew unwarranted conclusions therefrom.”).

We have reviewed the arguments made in the Appeal Brief (pages 7-11) but do not agree with Appellants that they have established that Piplani’s device does not meet the limitations of claim 12, for the reasons discussed in the Decision (pages 11-12).

Appellants also argue that Piplani refers to Lazarus (U.S. Patent 5,275,622) for additional details about the disclosed device (Req. Reh’g 7-8). According to Appellants, Lazarus teaches that “the longitudinal

distances between the apices should be minimized" (*id.* at 10 (emphasis removed)), that "the planes 141, 142, 143 should be staggered in the longitudinal direction by an amount slightly greater than the extent of each hook in the longitudinal direction" (*id.* at 11), and that "spacing between apices (at which the hooks are connected) should be no more than 1-2 millimeters" (*id.* at 11-12). Thus, Appellants conclude that "the new grounds of rejections are improper because they are not based upon apices having a longitudinal spacing of no more than 2 millimeters" (*id.* at 12).

We disagree with Appellants' interpretation of Lazarus. Appellants rely on Lazarus' description of its Figure 10, which is reproduced below (with unnecessary reference numerals omitted):



Lazarus states that Figure 10 shows "that spring means 131 have apices lying in three longitudinally spaced-apart parallel planes 141, 142 and 143 which are spaced with respect to the longitudinal axis of the tubular member 122" (Lazarus, col. 8, ll. 60-63). As Appellants point out, Lazarus discloses that

the spring force created by the helical coils 136 at the apices 133 is largely determined by the diameter of the wire. The greater the diameter of the wire, the greater the spring force applied to the struts or legs 137 and 138 of the vees. Also, *the longer the distances are between the apices lying in planes 141 and 142, the smaller the spring force that is applied to the legs or struts 137 and 138.* It therefore has been desirable to provide a spacing between the outer extremities of the legs or struts of approximately one centimeter, although smaller or larger distances may be utilized.

(Lazarus, col. 9, ll. 35-46, emphasis added.)

Appellants argue that “the italicized text indicates positively that *the longitudinal distances between the apices should be minimized.* What this means is that Lazarus teaches, and hence Piplani teaches, that the apices are in actual design close to one another relative to the other dimensions of the graft. Hence, this passage in Lazarus contradicts the panel’s conclusion upon which the new grounds are based.” (Req. Reh’g 10.)

We disagree. Lazarus states that the apices in plane 141 are “spaced from the end on which they are mounted” (Lazarus, col. 9, ll. 8-9). The passage quoted above simply states that the farther plane 141 is from the outer end of the tubular member (and plane 142), the lower the spring force applied to the struts or legs 137/138, and therefore, plane 141 should not be *too* far from the end of the tubular member. How far is too far, Lazarus does not say.

However, Lazarus does state that it “has been desirable to provide a spacing between the outer extremities of the legs or struts of approximately one centimeter” (*id.* at col. 9, ll. 42-46). This statement is most reasonably read to refer to the distance between planes 141 and 142, which are the “outer extremities” of the legs or struts that end in apices 133. Thus,

Lazarus expressly recommends that planes 141 and 142 be separated by a distance of one centimeter, “although smaller or larger distances may be utilized” (Lazarus, col. 9, ll. 45-46).

We do not agree with Appellants’ interpretation of Lazarus as “teach[ing] that the planes 141, 142, 143 should be staggered in the longitudinal direction by an amount slightly greater than the extent of each hook in the longitudinal direction” (Req. Reh’g 11). Appellants have pointed to no disclosure in Lazarus that supports the asserted teaching. Nor do we agree with Appellants that Lazarus teaches that “spacing between apices (at which the hooks are connected) should be no more than 1-2 millimeters” (*id.* at 11-12). The passages cited by Appellants as support for this teaching refer only to the size and orientation of the hook-like elements 151, not the spacing between the apices 133. As discussed above, we read Lazarus to recommend a spacing of one centimeter between the planes 141 and 142 in which the apices lie.

Finally, Appellants argue that “[g]iven that this case is under appeal and appellant[s] cannot submit new evidence, the new grounds of rejection is [sic] untenable” (Req. Reh’g 12).

This argument is also unpersuasive. An appellant has two options for responding to a new ground of rejection in a Board decision: file a request for rehearing or reopen prosecution by “[s]ubmit[ting] an appropriate amendment . . . or new evidence relating to the claims so rejected.” 37 C.F.R. § 41.50(b).

Appellants chose to rely on the evidence of record rather than submitting new evidence to the Examiner. For the reasons discussed above

Appeal 2007-0850
Application 10/733,292

and in the Decision, the evidence of record does not support Appellants' position.

REHEARING DENIED

Ssc:

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The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte GEOFFREY H. WHITE and WEIYUN YU

Appeal 2007-0850
Application 10/733,292
Technology Center 3700

Decided: May 18, 2007

Before DEMETRA J. MILLS, ERIC GRIMES, and LORA M. GREEN,
Administrative Patent Judges.

GRIMES, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a prosthesis for placement in intersecting blood vessels. The Examiner has rejected the claims as anticipated and obvious. We have jurisdiction under 35 U.S.C. § 6(b). We reverse the rejections based on the Cragg patent, vacate the rejections based on the Piplani patent, and enter new grounds of rejection.

Decision On Appeal - Ex parte Geofrey H. White and WeiYun Yu, 2007-0850

BACKGROUND

“It is known to use stents and intraluminal grafts of various designs for the treatment of aneurysms such as aortal aneurysms and for the treatment of occlusive diseases such as the occlusion of blood vessels” (Specification 1). For example, an intraluminal graft can be inserted into the aorta using a catheter, and “[u]pon the release of the graft from the catheter it expands to the size of the aorta above and below the aneurysms and bridges the aneurysms” (*id.*).

The Specification discloses an intraluminal graft having a tubular graft body supported by spaced apart malleable wires having “a generally closed sinusoidal or zig-zag shape, one of the wires being located adjacent to one end of the graft body such that alternate crests or apices of the wire project[] beyond at least part of that end” (*id.* at 2; *see also* Figures 2 and 3). The graft is placed in the desired location in the vessel, and a balloon within the graft is inflated “to cause the alternate crests or apices of the one wire to be urged into contact with the wall of the vessel” (*id.* at 2).

The Specification discloses that “[t]he wire crests may extend across the lumen of a vessel opening into the vessel in which the graft is being placed without occluding that lumen. This allows the intraluminal graft to be used in situations in which the aneurysm to be bridged commences closely adjacent [to] divergent blood vessels” (*id.* at 3).

DISCUSSION

1. CLAIMS

Claims 12-36 are pending and on appeal. Claims 12 and 20 are representative and read as follows:

12. A prosthesis for placement in a lumen of the first vessel that intersects with a second vessel, the prosthesis comprising:

a first end,
a second end, and

wherein at least one of the first and second ends is provided with a wire structure which has a plurality of apices extending beyond at least a portion of the corresponding end such that the plurality of apices extend across a lumen of the second vessel without occluding the lumen of the second vessel.

20. A prosthesis for placement in a lumen of the first vessel that intersects with a second vessel, the prosthesis comprising:

a first end adapted for placement adjacent to a junction between the first vessel and the second vessel, and

a second end,

wherein the first end is reinforced with a wire member which has a plurality of apices extending beyond at least a portion of the first end and across the junction between the first vessel and the second vessel such that the prosthesis does not occlude a lumen of the second vessel.

Thus, claims 12 and 20 are directed to prostheses capable of being placed in a first vessel that intersects with a second vessel. At least one end of the device has a wire structure that includes a plurality of apices extending from the end of the device such that the apices extend across the lumen of the second vessel without occluding it.

By reciting that the wire apices extend across the intersecting vessel's lumen, claims 12 and 20 recite the manner in which the device is to be used. It is well established that "[a]n intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than

define a context in which the invention operates.” *Boehringer Ingelheim Vetmedica v. Schering-Plough Corp.*, 320 F.3d 1339, 1345, 65 USPQ2d 1961, 1965 (Fed. Cir. 2003). Thus, an apparatus capable of performing an intended use will anticipate an apparatus claim, even if the prior art does not disclose that the apparatus was actually put to the intended use recited in the claim. See *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

We therefore interpret claims 12 and 20 to encompass any device having wire apices of sufficient length such that the apices are *capable* of extending across the lumen of a connecting vessel (and meeting the other claim limitations).

Claims 12 and 20 also limit the extending apical wire structure to one that does not occlude the lumen of the second vessel. During prosecution, the Examiner rejected the claims as indefinite because it was unclear whether “occlude” requires total occlusion or encompasses partial occlusion. Appellants argued that “[o]cclude means to shut or close. . . . Partially occlude means partially shut or partially block. Whether the structures defined by claim 20 partially shut or partially block the lumen of the second vessel is irrelevant because that is not what the applicant claims.”

(Amendment received July 6, 2005, at 10).

Positions taken during prosecution can limit the scope of the claims. See *Renishaw plc v. Marposs Societa per Azioni*, 158 F.3d 1243, 1249 n.3, 48 USPQ2d 1117, 1121 n.3 (Fed. Cir. 1998) (“Likewise, any interpretation that is provided or disavowed in the prosecution history also shapes the

claim scope.”). Here, Appellants have clearly stated that the claims require only that the apices do not *totally* occlude the lumen of the second vessel.

Thus, overall, we interpret claims 12 and 20 as encompassing an intraluminal graft device having the claimed apical wire structure, in which the wire apices are capable of extending across the lumen of a connecting vessel without completely shutting or closing the connecting vessel.

2. REJECTIONS OVER CRAGG

The Examiner relies on the following references:

Kornberg	US 4,617,932	Oct. 21, 1986
Lazarus	US 5,275,622	Jan. 4, 1994
Piplani	US 5,489,295	Feb. 6, 1996
Cragg	US 5,665,115	Sep. 9, 1997

3. REJECTIONS OVER CRAGG

Claims 21-36 stand rejected under 35 U.S.C. § 102(e) as being anticipated by, or in the alternative under 35 U.S.C. § 103(a) as obvious over, Cragg (Answer 5-6).¹

Claims 21-36 all ultimately depend from either claim 12 or claim 20. Claims 21-36 therefore all require the device’s wire structure to have apices capable of extending across the lumen of a second vessel without occluding it.

The Examiner contends that Cragg meets that limitation because Cragg discloses a prosthesis “provided with a wire structure 11 which has a plurality of apices extending beyond at least a portion of the corresponding

¹ Examiner’s Answer mailed September 21, 2006.

end (in the embodiment in which the graft 13 is shorter than the wire helix as described in col. 3, lines 29-31)” (Answer 5). Based on this disclosure, the Examiner concludes (*id.* at 5-6):

The apices are inherently capable of being located across a lumen of a second vessel since the prosthesis can be deployed in the first blood vessel to a position adjacent the intersection point of a second blood vessel such that the apices are located across a lumen of the second vessel. Alternatively, it would have been obvious that the apices are capable of being located across a lumen of a second vessel for this reason.

Appellants argue that the Examiner has not established that Cragg inherently discloses the device recited in claims 21-36 (Br. 18).

When a reference is silent regarding a particular element, an examiner may refer to extrinsic evidence to demonstrate that the asserted element is inherently present in the reference’s disclosure. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) (“[The] gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”)

However, as stated in *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting *Hansgirg v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)) (emphasis in original): “Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.”

We agree with Appellants that the Examiner has not established that Cragg meets the limitation requiring the wire apices to be capable of

extending across the lumen of an intersecting vessel. The Examiner relies on Cragg's statement that “[t]he graft 13 may be co-extensive with the wire helix; or it may be shorter than the wire helix” (Cragg, col. 3, ll. 29-31). The Examiner does not point to any other description of this embodiment in Cragg. The Examiner therefore appears to conclude that any apical wire structure extending from the end of an intraluminal prosthesis will inherently be capable of extending across an intersecting vessel.

We do not agree. As noted above, to establish inherency, the Examiner must demonstrate that the asserted inherent element is necessarily part of the reference's disclosure. *Continental Can*, 948 F.2d at 1268, 20 USPQ2d at 1749. However, Cragg does not state that the wire structures extending from the end of the device form apices; the drawings do not appear to show any extending wires that form a shape that would be considered an “apex.” In addition, Cragg does not state how far the wire structure may extend from the end of the device. Nor do the drawings provide any clear guidance regarding the proportions of the embodiment described at column 3, lines 29-31. Cragg therefore does not provide sufficient evidence to conclude that the embodiment relied on by the Examiner will necessarily have wire apices capable of extending across the lumen of an intersecting vessel.

Because the Examiner does not point to, and we do not see, sufficient evidence to establish that Cragg's device will necessarily have wire apices capable of extending across the lumen of an intersecting vessel, we do not agree that Cragg inherently meets that limitation. We therefore reverse the anticipation rejection based on Cragg.

The Examiner relies on the same inherency theory to establish obviousness (Answer 5-6). This rejection fails for the same reason as the anticipation rejection. Because the Examiner has not established that Cragg discloses or suggests a prosthesis having an apical wire structure capable of extending across the lumen of an intersecting vessel, we also reverse the obviousness rejection based on Cragg.

4. APPEALED REJECTIONS OVER PIPLANI

Claims 12-16, 19, 20, and 25-36 stand rejected under 35 U.S.C. § 102(e) as being anticipated by, or in the alternative under 35 U.S.C. § 103(a) as obvious over, Piplani (Answer 3-4).

The Examiner cites Figure 4 of Piplani as disclosing a prosthesis having a plurality of wire apices at the ends (*id.* at 3). The Examiner reasons that “[t]he apices are inherently capable of being located across a lumen of a second vessel” (*id.*): “if the prosthesis 20 is inserted into a patient who has arteries . . . which are closer to the aortic bifurcation 221 than the example shown in figure 19, then the apices 132 on wire structure 126 would be located across the lumen of each of the laterally extending arteries” (*id.* at 3-4).

The Examiner also points out that the claims “are drawn to a prosthesis for placement in a vessel in a certain location[,] . . . not . . . to a method of placing the prosthesis in a vessel in a certain location” (Answer 6). The Examiner urges that Piplani’s wire structure is “constructed in a manner similar to that . . . described in U.S. Patent 5,275,622” (Answer 7), which in turn discloses that the wire structure “extends beyond the end of the graft by a relative[ly] large distance of 1 cm” (*id.* at 8). Based on this, the

Examiner concludes that “the Piplani et al. wire structure 126 inherently extends sufficiently far beyond the end of the graft to extend completely across a lumen of the second vessel, as claimed, since it extends farther beyond the end of the graft than appellant’s invention” (*id.*).

As discussed *supra*, inherency may not be based on probability or possibility. *In re Oelrich*, 666 F.2d at 581, 212 USPQ at 326. In our view, the Examiner’s reasoning does not adequately support a case of inherency. For example, the fact that Piplani’s wire structure is made “in a manner similar” to Lazarus’ wire structure (Answer 7, *see also* Piplani, col. 5, ll. 34-40), does not mean that Piplani’s structure will necessarily have the same dimensions as Lazarus’ structure.

However, our review of Piplani leads us to conclude that the reference anticipates many of the appealed claims, but for reasons different than those advanced by the Examiner. We therefore vacate the Examiner’s rejections based on Piplani and enter the new rejections set out below.

5. ANTICIPATION BY PIPLANI

Under the provisions of 37 CFR § 41.50(b), we enter the following new ground of rejection: claims 12-16, 19, 20, 22, and 24-36 are rejected under 35 U.S.C. § 102(e) as anticipated by Piplani.

Piplani describes a tubular bifurcated intraluminal graft prosthesis, having first and second ends (Piplani, Figure 4). The device can be placed in the lumen of a first vessel that intersects a second vessel (*see id.* at Figures 13 through 19). The device’s main body can be from five to thirty centimeters long, with a diameter of from twelve to thirty millimeters (*id.* at col. 5, ll. 16-22).

Piplani's device comprises an expandable spring attachment means 126, having a generally sinusoidal or zig-zag shape, with a plurality of wire apices 132 that extend from the body of the graft (*id.* at Figure 4; col. 5, ll. 29-58.) The spring attachment must be physically expanded "from an initial compressed or collapsed position to a subsequent expanded position" to allow it to press against the inner surface of a vessel (*id.* at col. 5, ll. 39-40). Piplani's device also has first and second wires not at the end of the prosthesis (*id.* at col. 5, ll. 23-27).

Regarding the limitation in claims 12 and 20 requiring the device's wire apices to be capable of extending across an intersecting vessel, Piplani discloses that

the apices 132 lie in three longitudinally spaced-apart parallel planes extending transversely of the axis of the expandable spring attachment means in which the first plane is disposed internally of the open end and the second plane lies in a position which is external of but in close proximity to the open end *and the third plane is spaced a substantial distance beyond the open end.*

(*Id.* at col. 5, ll. 51-58, emphasis added.)

Thus, Piplani's graft has two sets of wire apices that extend beyond the body of the graft. One set of apices is "in close proximity" to the open end of the graft, while the other set of apices is "a substantial distance" from the end of the graft (*id.* at col. 5, ll. 55-58).

In view of the drawings, the explicitly stated dimensions, and the disclosure that one set of wire apices extends "a substantial distance" from the body of the graft, it is reasonable to conclude that the wire apices of Piplani's device would extend a sufficient distance from the body of the

graft such that the apices would be capable of extending across the lumen of an intersecting vessel, including a renal artery. Therefore, Piplani's device reasonably appears to meet the structural limitations of claims 12-16, 19, 20, 22, and 24-36.

As stated in *In re Best*, 562 F.2d 1252, 1254-55, 195 USPQ 430, 433 (CCPA 1977):

[W]here the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

In reviewing Appellants' arguments, we do not find any evidence demonstrating that this conclusion is not reasonable. On the current record, Appellants have not met their burden under *In re Best* of establishing a difference between the claims and prior art.

Appellants urge that Piplani teaches away from deploying the graft in the manner recited in claim 12 and 20 (Br. 9). However, as discussed *supra*, a prior art device capable of performing the intended use will anticipate an apparatus claim, even if the device is not actually used in the manner recited in the claim. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Moreover, "the question whether a reference 'teaches away' from the invention is inapplicable to an anticipation analysis."

Celeritas Techs. Ltd. v. Rockwell Int'l Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522 (Fed. Cir. 1998) (citation omitted).

Appellants argue that placing Piplani's device in a vessel with the apices across an intersecting vessel lumen would yield a non-functional result because the lumen would not exert enough tension on the wire structure to allow the hooks opposite the lumen to penetrate the vessel wall (Br. 10). We do not find this argument persuasive.

Piplani discloses that the apices of the device extend "a substantial distance" from the body of the graft, and therefore Piplani's device reasonably appears to comprise apices capable of extending across the lumen of an intersecting vessel without completely occluding it. The device disclosed by Piplani therefore meets the structural limitations of the instant claims. It makes no difference, with respect to anticipation, whether the hooks on Piplani's device would function as intended if it were deployed as proposed by Appellant.

Appellants further argue that Piplani does not describe the apices being in a generally zig-zag or sinusoidal configuration (Br. 11-12; Reply Br. 5-6). We do not agree. The claims require only a "generally" sinusoidal or zig-zag structure. The term "generally" encompasses some variation, including the structure of the expandable spring attachment depicted in Figure 4.

Appellants further argue that Piplani does not disclose first and second wires not at the end of the prosthesis (Br. 12). We do not agree. Piplani states that "[r]adiopaque markers 121 are provided on the main body 112 . . . and can be formed of a suitable material *such as lengths of platinum wire* secured to the fabric of the graft by suitable means . . ." (Piplani, col. 5, ll. 23-27, emphasis added).

To summarize, one of ordinary skill viewing Piplani would have reasonably concluded that the disclosed device meets all the limitations in claims 12-16, 19, 20, 22, and 24-36.

6. OBVIOUSNESS OVER PIPLANI

Under the provisions of 37 C.F.R. § 41.50(b), we enter the following new ground of rejection: claims 17, 18, 21, and 23 are rejected under 35 U.S.C. § 103(a) as being obvious over Piplani and Kornberg.

As discussed *supra*, Piplani describes a prosthetic device meeting all of the limitations of claims 12-16, 19, 20, 22, and 24-36. Piplani does not disclose that the apical wire structure is formed of stainless steel, as recited in claim 17, or of biocompatible plastic, as recited in claim 18. Nor does Piplani disclose that the apices are formed of a malleable material, as recited in claims 21 and 23.

However, as pointed out by the Examiner (Answer 5), Kornberg teaches that “flexible resilient plastic” and “surgical steel” were known to be suitable as support materials for aortic grafts (Kornberg, col. 4, ll. 8-17 and 25-29). Because malleable plastic and surgical steel were known to be useful as support materials for aortic grafts, one of ordinary skill would have considered it obvious to use those materials to construct the expandable spring attachment that supports Piplani’s graft device.

Appellants argue that the combination of Piplani and Kornberg does not render claims 17 and 18 obvious because Kornberg does not remedy Piplani’s failure to anticipate independent claim 12 (Br. 16-17). We do not find this argument persuasive. As discussed *supra*, in our view, one of

ordinary skill would have reasonably concluded that Piplani discloses all of the limitations in claim 12.

To summarize, we agree with the Examiner that Piplani anticipates claims 12-16, 19, 20, 22, and 24-36, and renders claims 17, 18, 21, and 23 obvious when viewed with Kornberg. However, because we base these conclusions on a rationale different from that applied by the Examiner, we designate these as new grounds of rejection. 37 C.F.R. § 41.50(b).

SUMMARY

We reverse the anticipation and obviousness rejections over Cragg. We vacate the Examiner's rejections using the Piplani reference, and enter new anticipation and obviousness rejections based on that reference.

Time Period for Response

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner

Appeal 2007-0850
Application 10/733,292

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record

REVERSED, 37 C.F.R. § 41.50(b)

lbg

NEIFELD IP LAW, PC
4813-B EISENHOWER AVENUE
ALEXANDRIA VA 22304

Electronic Acknowledgement Receipt

EFS ID:	3001083
Application Number:	10733292
International Application Number:	
Confirmation Number:	2518
Title of Invention:	Intraluminal graft
First Named Inventor/Applicant Name:	Geoffrey H. White
Customer Number:	31518
Filer:	Robert W. Hahl
Filer Authorized By:	
Attorney Docket Number:	EDWA0018U-US
Receipt Date:	14-MAR-2008
Filing Date:	12-DEC-2003
Time Stamp:	14:35:02
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	yes
Payment Type	Credit Card
Payment was successfully received in RAM	\$ 130
RAM confirmation Number	8691
Deposit Account	
Authorized User	

File Listing:

Document Number	Document Description	File Name	File Size(Bytes) /Message Digest	Multi Part /zip	Pages (if appl.)

1		Petition181_EDWA0018U-U S_3-14-2008.pdf	397797 78288092a2f2d7ba19834f12b7f44bb0e 5bb943e	yes	5		
Multipart Description/PDF files in .zip description							
	Document Description		Start	End			
	Miscellaneous Incoming Letter		1	1			
	Petition for review by the Technology Center SPRE.		2	5			
Warnings:							
Information:							
2	Fee Worksheet (PTO-06)	fee-info.pdf	8131 cba6b798a5f4fc94b88ad59f000a5ccb5 dd38ac	no	2		
Warnings:							
Information:							
Total Files Size (in bytes):				405928			
<p>This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.</p> <p>New Applications Under 35 U.S.C. 111 If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.</p> <p>National Stage of an International Application under 35 U.S.C. 371 If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.</p> <p>New International Application Filed with the USPTO as a Receiving Office If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.</p>							

Neifeld Docket No: EDWA0018U-US

IN RE APPLICATION OF: White et al.
USPTO CONFIRMATION CODE: 2518
APPLICATION NO: 10/733,292
FILED: 12/12/2003
EXAMINER: Michael Thaler
GROUP ART UNIT: 3731
FOR: INTRALUMINAL GRAFT

**37 CFR 1.7(c) FILING RECEIPT AND TRANSMITTAL LETTER WITH
AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

**1. THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY FEES
WHICH MAY BE REQUIRED, OR CREDIT ANY OVERPAYMENT, TO DEPOSIT
ACCOUNT NUMBER 50-2106.**

2. FEES PAID HEREWITH BY EFS CREDIT CARD SUBMISSION: \$130

3. THE FOLLOWING DOCUMENTS ARE SUBMITTED HEREWITH:

37 CFR 1.181 PETITION (4 pages)

4. FOR INTERNAL NEIFELD IP LAW, PC USE ONLY

USPTO CHARGES: \$130 CLIENT BILLING MATTER: EDWA0010A BANK ACCOUNT/Check: 6/348 G/L ACCOUNT: 2500	FIRM CHARGES: \$300 DESCRIPTION: FIRM CHARGE FOR LAWYER: RWH
--	--

**INITIALS OF PERSON WHO ENTERED ACCOUNTING DATA: RWH
ATTORNEY SIGNATURE (AUTHORIZING DEPOSIT ACCOUNT)**

DATE: 3/14/2008

SIGNATURE:/RobertHahl#33,893/

Printed: March 14, 2008 (3:27pm)

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NEIFELD DOCKET NO: EDWA0018U-US
IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: White et al.
USPTO CONFIRMATION CODE: 2518
APPLICATION NO: 10/733,292
FILED: 12/12/2003
EXAMINER: Michael Thaler
GROUP ART UNIT: 3731
FOR: INTRALUMINAL GRAFT

ASSISTANT COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313

37 CFR 1.181 PETITION

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C.

I. Statement of the Precise Relief Requested

The applicant requests that the Director withdraw the Notice of Abandonment, dated March 7, 2008.

II. Material Facts in Support of the Petition

Fact 1. A Decision on Appeal was decided by the Board of Patent Appeals and Interferences on May 18, 2007.

Fact 2. Appellant then filed a Request for Rehearing on July 3, 2007, which is within two months of May 18, 2007.

Fact 3. The Decision on Request for Rehearing issued on January 25, 2008.

Fact 4. A Notice of Appeal to the United States Court of Appeals for the Federal Circuit is being filed herewith (March 14, 2008), which is within two months of January 23, 2008.

Fact 5. A Notice of Abandonment was issued on March 7, 2008.

Fact 6. 37 C.F.R. §41.52(a) states that:

(a)(1)Appellant may file a single request for rehearing within two months of the date of the original decision of the Board. No request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original decision as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section. When a request for rehearing is made, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for

appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing.

Fact 7. 37 C.F.R. §1.304 states in relevant part:

(a)(1) The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (§1.302) or for commencing a civil action (§1.303) is two months from the date of the decision of the Board of Patent Appeals and Interferences. If a request for rehearing or reconsideration of the decision is filed within the time period provided under §41.52(a), §41.79(a), or §41.127(d) of this title, the time for filing an appeal or commencing a civil action shall expire two months after action on the request....

III. Reasons Why the Relief Requested Should be Granted

The Notice of Abandonment dated March 7, 2008 is erroneous because the application was pending. 37 C.F.R. §41.52(a).

This Petition is not moot because the applicant has filed a Notice of Appeal to the CAFC. 37 CFR 1.304. Therefore, the application is still pending.

IV. Conclusion

The Director should issue a paper formerly withdrawing the Notice of Abandonment dated March 7, 2008, and acknowledge that this application is pending, so that the appeal to the CAFC may continue.

Respectfully Submitted,

3/14/2008

Date

/Robert Hahl#33,893/
Robert W. Hahl, Ph.D.
Registration No. 33, 893
Attorney of Record

Richard A. Neifeld

Attorney of Record
Registration No. 35,299

RWH

March 14, 2008 (3:27pm)

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BPAI Appeal No. 2007-0850
Application No. 10/733,292
Neifeld Docket No. EDWA0018U-US

PROOF OF SERVICE

I hereby certify that today, March 14, 2008, I dispatched true and correct copies of the following documents:

NOTICE OF APPEAL to the Court of Appeals for the Federal Circuit
for review of the Decision on Request for Rehearing of the Board of Patent Appeals and Interferences in Appeal No. 2007-0850 in Application Serial No. 10/733,292; and

37 CFR 1.181 PETITION to the Director, U.S. Patent and Trademark Office, in Application Serial No. 10/733,292.

via United States Postal Service Express Mail to:

General Counsel
United States Patent and Trademark Office
Office of the Solicitor
P.O. Box 15667
Arlington, VA 22215

- and -

CLERK OF COURT
United States Court of Appeals for
the Federal Circuit
Room 401
717 Madison PI., NW
Washington, DC 20439



Robert W. Hahl, Ph.D.
Registration No. 33,893
Neifeld IP Law, PC